

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Philippe GUEDAT, et al.

Serial No.: 10/561,989

Group Art Unit: 1625

Filed: December 23, 2005

Examiner: CHANG, Celia C.

Title: THIAZOLYLPIPERIDINE DERIVATIVES AS MTP INHIBITORS

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed on October 6, 2008, applicants elect with traverse Group I, claims 10 and 15. As a species applicants elect with traverse N-methyl-N-(1-methyl-2-oxo-2-phenethyl)-2-[1-(4'-trifluoromethylbiphenyl-2-carbonyl)piperid-4-yl]thiazole-4-carboxamide, which is the ninth compound in claim 15 and is disclosed in the specification on page 46 as compound number 38.

The traversal is on the grounds that the patent office has not established that it would pose an undue burden to examine the full scope of the claimed invention.

Applicants remind the Examiner of 37 CFR 1.141, according to which an applicant is entitled to consideration of claims to additional species which are written in independent form or otherwise include all the limitations of an allowed generic claim.

Additionally, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that "if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined." If the restriction requirement is maintained at this point, rejoinder of non-elected claim 18, which will be rewritten as a method of treatment claim of the therein identified indications is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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Attny. Docket No.: Merck-3095

Filed: October 16, 2008

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